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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,554	11/09/2001	Hajime Ashihara	Q67202	5906

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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Washington, DC 20037-3213

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/986,554	Applicant(s) ASHIHARA, HAJIME	
	Examiner Robert M. Pond	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Interview (2/28/2007).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-10 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-10 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. All pending claims 5-10 and 15-20 were examined in this non-final office action necessitated by new grounds of rejection.

Response to Arguments

Applicant's arguments, see Remarks, filed 27 November 2006 and subsequent discussions held as documented in the Examiner Interview Summary 22 February 2007, with respect to the rejection(s) of claim(s) 5-10 and 15-20 under 35 USC 103(a) have been fully considered and are persuasive. Rejection was withdrawn via the Examiner's Interview held February 2007 and entered into the patent application case record 28 February 2007. However, upon further consideration, a new ground(s) of rejection is made in view of Iron Planet and AutoAdvisor. Prior art Woolston, Walker and Buyclassiccars.com previously cited are withdrawn thereby rendering arguments moot.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claim 5-10 and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The Applicant claims an agent server that serves as an intermediary between a buyer and a seller via a communications network. Via the communications network, the agent server provides a listing of items to the user sold only at sales shops and not accessible via a communications network. Via the communications network, the agent server confirms a purchase order by the user for items. Items that are sold only at sales shops are actually sold by the agent server thereby creating an inoperative invention as claimed. The items sold only at sales shops are accessible via the communications network. Correction is required. Examination was based on items not accessible to the buyer due to physical location.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 2. Claims 5-10 and 15-20 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.**

The Applicant claims an agent server that serves as an intermediary between a buyer and a seller via a communications network. Via the communications

network, the agent server provides a listing of items to the user sold only at sales shops and not accessible via a communications network. Via the communications network, the agent server confirms a purchase order by the user for items. Items that are sold only at sales shops are actually sold by the agent server thereby creating an inoperative invention as claimed. The items sold only at sales shops are accessible via the communications network. Correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 5-10 and 15-20 are rejected under 35 USC 103(a) as being unpatentable over Iron Planet (PTO-892, Item: U, 28 pages) in view of AutoAdvisor (PTO-892, Item: V, 15 pages).

Iron Planet teaches a full service marketplace used for buying equipment. Iron Planet offers inspected equipment, inspection reports and insured transactions. U: see at least pages 1 and 29. Iron Planet dispatches an inspector to the listed equipment physical location, produces a search report for the listed equipment and posts the inspection report for that listed item on the web site. U: see at least pages 11-19. Iron Planet further teaches:

- Regarding claim 5. transmitting sales information from an agent server to a user terminal via a communication network, wherein the sales information includes product listings for a plurality of items which are sold only at sales shops that are not accessible via said communications network; items listed review are accessible to a potential buyer or potential seller t review. U: see at least pages 1 and 19.
- Regarding claim 5. displaying, at said user terminal, the transmitted sales information which is received from the agent server, items listed review are accessible to a potential buyer or potential seller t review (U: see at least pages 1 and 19). Iron Planet teaches all the above as noted under the 103(a) rejection and teaches i) an Internet-based service receiving search requests from users, ii) transmitting a list of items at selling locations physically located in various geographic regions of the world and not accessible directly via a communications network, iii) using inspectors to visit the selling site of a listed item to perform an inspection and to produce an inspection report available online to users (buyers and sellers) and iv) charging fees for services. Although Iron Planet does not mention wherein the user terminal transmits a first search request signal to said server to request a service charge associated with performing a search by an agent at specified sales shops which are selected by the user, among the sales shops that are not accessible via said communications network for a desired item if the desired item is not included among the plurality of

items included in the product listings and the service charge associated with performing the search is requested by the user; AutoAdvisor teaches a user requesting an Internet-based buyer service (www.autoadvisor.com) to locate, for a fee, equipment (e.g. vehicle) as specified by the user making the request. V: see at least pages 1-5. AutoAdvisor further teaches reviewing existing inventory (information only available to AutoAdvisor but not available to the user) of dealers in the user's area (note: user picks the area). V: see at least page 5. One of ordinary skill in the art at time the invention was made would have recognized that applying the known techniques of AutoAdvisor requesting a search for a vehicle at specified seller location would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the techniques of AutoAdvisor to the teachings of Iron Planet transmitting a listing of items from physical selling locations around the world with access to the item's inspection report would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data processing features into similar systems. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. vs. Teleflex Inc.*

- Regarding claim 5. It would have been obvious to try, by one of ordinary skill in the art at time the invention was made, to incorporate into the

system of Iron Planet and AutoAdvisor additional features of AutoAdvisor as noted below since there are a finite number of identified, predictable potential solutions to the recognized need and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. vs. Teleflex Inc.*

- determining, at said agent server, said service charge based on contents of the first search request signal and a cost database, and transmitting the service charge that is determined to said user terminal;
\$200 fee to locate a vehicle. AutoAdvisor: V: see at least page 5 (START YOUR SEARCH).
- displaying, at the user terminal, the service charge that is transmitted from the agent server, fee displayed to user (V: see at least page 5) wherein the user terminal transmits a second search request signal to said server if search for the desired item is instructed by the user;
clickable icon allows buyer to request search subsequent to receiving fee information. AutoAdvisor: V: see at least page 5 (ORDER NOW!).
- Regarding claim 5. transmitting, from the agent server, a search report which includes results of the search for the desired item performed by the agent at the specified sales shops that are not accessible via said communications network of said desired item to said user terminal;

user receives search report. AutoAdvisor: V: see at least pages 4 and 5.

Iron Planet and AutoAdvisor further teach and suggest:

- Regarding claim 5. displaying, at the user terminal, the transmitted search report, user receives search report (AutoAdvisor: V: see at least pages 4 and 5). Iron Planet and AutoAdvisor teach and suggest all the above as noted under the 103(a) rejection and teach and suggest i) the buyer transmitting a purchase order to the Iron Planet service (note: buyer submits bid price, the bid being a binding offer, the winning bid serving as a purchase order and the system completes the sales transaction (Iron Planet: U: see at least pages 24-25) and ii) the buyer buying directly from the selling location as searched and identified by the locating service (AutoAdvisor: V: see at least page 13). It would have been obvious to try, by one of ordinary skill in the art at time the invention was made, to incorporate into the system of Iron Planet and AutoAdvisor the buyer confirming an order via the service since there are a finite number of identified, predictable potential solutions to the recognized need and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. vs. Teleflex Inc.*

- Regarding claim 5. Iron Planet and AutoAdvisor teach and suggest all the above as noted under the 103(a) rejection and teach and suggest i) the buyer transmitting a purchase order to the service and ii) confirming the purchase order via the service and iii) once the buyer has placed 100% of the funds in to the secure bank account (note interpretation: buyer billed and starts depositing funds into the account), Iron Planet will notify both the buyer and seller that the money has been deposited (note interpretation: purchase order accepted). U: see at least pages 25. It would have been obvious to try, by one of ordinary skill in the art at time the invention was made, to incorporate into the system of Iron Planet transmitting, from the agent server, an acknowledgment message to said user terminal in response to said purchase order which is received from the user terminal, wherein the acknowledgement message indicates that the purchase order has been accepted since there are a finite number of identified, predictable potential solutions to the recognized need and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. vs. Teleflex Inc.*
- Regarding claims 6-10 and 15-20. Rejections are based on the teachings and rational as noted above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 7,403,915 (Bundy et al.) 22 July 2008 (provisional 10 April 2000); teaches system and methods Iron Planet's online selling system providing inspection reports of listed items.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Robert M. Pond/
Primary Examiner, Art Unit 3625
August 4, 2008